

REMARKS

Claims 6-12 are pending in the application. Claims 9 and 11 have been amended.

Claim 9 has been amended to correct a typographical error, converting “if” to –of--. Claim 11 has been amended to recite that the label does not extend radially outward of any data tracks on the compact disk, for example, as supported in paragraph 25 of the published application.

Claims 6-12 stand rejected under §103(a), as being unpatentable over Kahle (US 5,518,325). Claim 6 distinguishes Kahle ‘325 by reciting a step of “manually pressing said label onto said compact disk with use of a base plate and a pestle.” We respectfully traverse the rejection. In particular, we traverse statements in the carryover paragraph on page 2 of the Office Action dated November 5, 2003, that Kahle ‘325 discloses and equivalent to the claimed use of a base plate and pestle. Kahle ‘325 does not show any equivalents whatsoever.

The relevant passages from Kahle ‘325 in describing the attachment of a self-adhesive label are found in column 3 at lines 1-2 (a separate label is automatically attached to the compact disk); column 5 at lines 27-38 (an attachable label 20 can be attached to the labeling portion 16); and column 9 at lines 11-36 (a mechanical device “(not shown)” is used to attach the label to the CD-R). What Kahle ‘325 says is that a mechanical device that is not shown” is used to “automatically” attach the adhesive label to the CD. This is very different from the claimed step of “manually pressing said label onto said compact disk with use of a base plate and a pestle,” at least because the claimed manual function is not automatic and because Kahle ‘325 does not specify anything other than an unspecified mechanical device.”

The Office characterizes the claimed use of a base plate and a pestle as an “equivalent” that would perform equally well with any known equivalent elements. This cannot be true with respect to Kahle ‘325, since the alleged equivalent elements are “not shown,” and are merely identified as a “mechanical device” (column 9 lines 31-33). The rejection as stated lacks anything that teaches or suggests the use of a pestle and base plate to attach an adhesive label on a compact disk. The asserted “mechanical device” that is “not shown” in Kahle ‘325 does not teach or suggest the claimed use of a base plate and pestle.

The Office further states that Applicants have not shown that the use of the combination

including a base plate and pestle solves any stated problem or is for any particular purpose. We respectfully disagree, and direct attention to:

- The Abstract “A very close tolerance between the cylinder, the disk, the top layer, and the pestle provides a substantially perfect central alignment of the top layer on the disk;”
- Paragraph 13 of the published application, “A pestle is used to press the sticker against the compact disk when the cylinder is inserted through a hole in the disk and a central opening in the sticker. The system serves to align the sticker on the disk;” and
- Paragraphs 28-33 of the published application provide a discussion of preferred tolerances and structure for accomplishing these aims, e.g., “Disk 40 is retained on platform 58 in a substantially perfect central alignment with respect to centerline 72 by virtue of the close 0.2 mm tolerance between sidewall 64 and the inner diameter defining hole 42.”

Thus, the Specification does disclose that a close central alignment of the compact disk and the adhesive label may be accomplished by the claimed use of the base plate and pestle. Kahle ‘325 proposes no specific equivalent structures for accomplishing this aim and merely asserts the use of an automated “mechanical device.” The emphasis in Kahle ‘325 is upon an automated mechanical device, which teaches away from the claimed manual use of a base plate and pestle.

Although the Office asserts that Kahle ‘325 describes the use of a destructible label with respect to claim 12, we respectfully disagree. The passage relied upon by the Office in support of that position exists at column 5, lines 27-33. We read that passage as describing merely the use of a “self-adhesive” label (column 5, line 35), but not a destructible label, for example, as described in paragraphs 12, 33 and 40 of the published application. Kahle does not teach or suggest the use of a destructible label.

Claim 11 has been amended to clarify that the label does not extend radially outboard of data tracks on the CD, which permits the use of two sided CD’s. This limitation distinguishes Kahle ‘325 where, for example, Fig. 1 shows a label extending substantially over the entire data portion of disk 10.

Applicants' attorney respectfully solicits a Notice of Allowance in this application. The Commissioner is authorized to charge any additionally required fees to deposit account 12-0600. Applicants' attorney urges Examiner Fridie to telephone if a conversation could expedite prosecution.

Respectfully submitted,
LATHROP & GAGE L.C.

By: _____

A handwritten signature in black ink, appearing to read 'Dan Cleveland, Jr.', written over a horizontal line.

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